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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,152	11/16/1999	TOSHIHIRO SHIMA	04783.010001	5476

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/15/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/442,152

Applicant(s)
Shima

Examiner
Mark Wallerson

Art Unit
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 5/23/2003.

2. This application has been reconsidered. Claims 1-13 are pending.

NOTE: In Applicant's reply filed on 5/23/2003, the serial number of the application was erroneous (09/422,152). This should be changed to 09/442,152 in future communications.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels (U. S. 6,222,634) in view of Huttenlocher (U. S. 6,011,905).

With respect to claims 1, 6, and 10, Dubbels discloses a printer system (figure 5) comprising a first request means (210) which directly makes a first request for obtaining a resource from a server (610) (in the best mode of the Dubbels invention, the web page printer is

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integrated into the web browser) (column 7, lines 3-12); listing means (540) for determining a list of resources from the server (column 8, lines 1-38); setting means (540) for setting pages to be printed based on the structure of the determined source (column 7, lines 16-17); second request means (550) which makes a second request for obtaining structural data within the pages to be printed (column 6, lines 27-52 and column 7, lines 17-20); means (560) for generating print data based on the second response; and printing means (printer) for printing based on the generated data (column 2, lines 60-62, column 4, line 61 to column 5, line 5; and column 6, line 62 to column 8, line 64).

Dubbels differs from claim 1, 6, and 10 in that he does not clearly disclose structure means for determining a structure of the resource. However, Dubbels teaches a list of web pages, generally written in HTML, which allows the user to select pages to print. A list of information resources in different formats (figure 7) such as GIF and JPG and links 740 and 750 allow a user to go to related web pages. When all the related links are passed and a list of related links is built, a display (800) results (figure 8) which includes a list (810) of related links and a button (820) for the user to select pages to be printed (column 8, lines 1-38).

Huttenlocher teaches that HTML allows markup of the structure of the document (column 1, line 66 to column 2, line 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teaching of Huttenlocher in Dubbels in order to use HTML to determine the structure of the documents.

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With respect to claims 2, 3, 7, 8, Dubbels does not clearly disclose judging the data format of the structural data and whether the structural data is printable data. However, Dubbels teaches that when web server (220) receives a web page request, it builds a web page in HTML and sends it to the requesting web browser (210). The web browser understands HTML and interprets it and outputs the web page to the monitor of the user workstation. Figure 7 depicts different formats that the web browser judges in order to convert them into printable data (column 8, lines 1-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to have understood that the printing system includes judging means for judging the data format of the structural data since the web browser interprets the data in different formats and outputs the web page(s) to the monitor (column 2, lines 60-62; column 3, lines 13-18; column 4, line 61 to column 5, line 5 and column 8, lines 55-64).

With regard to claims 4, 5, 9, 11, and 12, Dubbels does not clearly disclose that the data format is moving picture data and the second request means obtains the structural data with the offset value from the top position of the resource. Huttenlocher discloses that HTML provides more flexibility than ASCII, in that it supports embedded graphics, images, audio and video recordings and hypertext linking capabilities (column 2, lines 2-5). Huttenlocher also discloses a structural document with an imaginary nonempty strip just above the top of the image which is used to compute the offset value (column 23, line 64 to column 24, line 7), therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dubbels by the teaching of Huttenlocher in order to obtain a resource from the server and

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discriminate different formats and means for generating print data to be printed, wherein the resource is written in HTML (figure 10).

With regard to claim 13, Huttenlocher discloses that the structural means determines the page layout of the resource based on information relating to the size of data and information relating to the position of data and the setting means sets the pages to be printed in accordance with the determined page layout (column 1, lines 29-38; column 2, lines 2-32; column 22, line 36 to column 24, line 53 and column 26, line 15 to column 28, line 31).

Response to Arguments

5. Applicant's arguments filed 5/23/2003 have been fully considered but they are not persuasive.

Applicant submits that the assertion that Dubbels is equivalent to a printer is incorrect and that the printer in Dubbels is not in direct communication with the server. The Examiner respectfully disagrees. The invention of Dubbels is described as "Apparatus and method for printing related web pages" (column 1, lines 7-8). Dubbels also discloses that his invention comprises a web client print mechanism 320 that is used to **print** individual web pages (emphasis added) (column 5, lines 26-28). Accordingly it is clear that the apparatus in Dubbels is either a printer or equivalent to a printer since it is being used for printing. Contrary to Applicant's assertion on page 11 of the amendment filed on 5/23/2003, Dubbels does NOT disclose a separate printer.

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Further, Dubbels discloses that, in the best mode of his invention, the web page print mechanism is integrated into the web browser thus providing a browser with advanced web page printing capability (column 7, lines 5-9). This clearly indicates that if the browser is integrated in the printer, the printer would be in direct connection with the server.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

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MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON